REMARKS

Claims 1-11, 13-18, 20-42, 45-51, and 55-86 are pending. Claims 34-37, 46, and 51 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2002/0129358 to Buehl et al. Claims 38-42, 45, 47, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0129358 to Buehl et al. in view of U.S. Patent No. 6,898,762 to Ellis et al. Claims 49 and 67-86 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0129358 to Buehl et al. in view of U.S. Patent Application Publication 2001/014975 to Gordon et al. Claim 50 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0129358 to Buehl et al. in view of U.S. Patent No. 6,539,548 to Hendricks et al. Claims 1-11, 17, 20, 23, 32, and 55-66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2001/014975 to Gordon et al. in view of U.S. Patent Application Publication 2002/0129358 to Buehl et al.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 1-11, 13-18, 20-42, 45-51, and 55-86 remain in the case for consideration.

REJECTIONS UNDER 35 U.S.C. § 102(e)

Referring to claim 34, the invention is directed toward a method for delivering digital content, the method comprising: receiving a request for the digital content from a unit in a multiple unit environment at a server; accessing the digital content from a memory on the server; delivering the digital content to the unit, the delivery of the digital content being independent of an asynchronous delivery of a second digital content to a second unit in the multiple unit environment; accessing a default rate for the digital content; accessing a custom rate for the digital content; accessing a rate key from a user profile; and selecting the default rate or the custom rate for the digital content, based on the rate key.

In contrast, Buehl teaches systems and methods that divide the billing function of a billing system from the provisioning function of a service in digital cable systems. A customer's price is computed by an application associated with a service. That price is sent to a billing system with metadata and used by the billing system to compute the actual price. *See* Buehl, Invention Disclosure Form, Background and Description, ¶ 1.

The Examiner has cited to U.S. Published Patent Application 2002/0129358 to Buehl et al. as teaching the features of claims 34-37, 46, and 51. In particular, the Examiner points to ¶¶ 0039-0041 and 0049 as teaching the features of the default rate, the custom rate, and the rate key.This patent application was filed on March 29, 2001. Buehl was filed on January 18,

2002, claiming priority from U.S. Provisional Patent Application Serial No. 60/097,538, filed on January 22, 2001. As this patent application was filed before Buehl filed his utility patent application, the filing date of the Buehl utility patent application does not provide the critical date for a reference under 35 U.S.C. § 102(e). Thus, for Buehl to be a proper reference under 35 U.S.C. § 102(e), the Examiner is relying on the fact that the Buehl provisional patent application was filed before the filing date of this patent application.

Under MPEP § 2136.03, section III, "[t]he 35 U.S.C. § 102(e) critical reference date of . . . U.S. application publications . . . entitled to the benefit of the filing date of a provisional application under 35 U.S.C. § 119(e) is the filing date of the provisional application with certain exceptions **if** the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph" (emphasis in original, cross-referenced to MPEP § 706.02(f)(1)). This theme is repeated in MPEP § 201.11, section I.A: "for a nonprovisional application to be afforded the priority date of the provisional application, 'the specification of the provisional must "contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms" to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application'" (emphasis in original, quoting New Railhead Mfg., LLC. v. Vermeer Mfg. Co., 298 F.3d 1290, 1294 (Fed. Cir. 2002) (quoting 35 U.S.C. § 112, ¶ 1)).

The provisional application of Buehl does not provide a written description of a default rate and a custom rate, or a rate key sufficient to enable one of ordinary skill in the art. The closest Buehl comes to suggesting that there might be different rates used for different customers is in the description section of the Invention Disclosure Form of the provisional patent application, where Buehl states that "[w]hen the customer makes the purchase, the customer's price is computed by the application, and that price is sent to the billing system with the metadata which is used by the billing system to compute the actual price". This sentence is all that the Buehl provisional patent application recites on the subject of customer price: nowhere else does the Buehl provisional patent application teach or suggest anything on the subject of billing. In particular, nowhere does the Buehl provisional patent application discuss anything about rate keys of any sort, let alone default and custom rate keys. The fact that an application might compute a customer's price does not explain how such a price is computed.

Thus, the Buehl provisional patent application fails to teach or suggest the features of a default rate, a custom rate, or a rate key, and with respect to those features, the Buehl utility patent application cannot claim priority back to the filing date of the Buehl provisional patent

application. As a result, at least with respect to the indicated features of the claims, the critical reference date under 35 U.S.C. § 102(e) for the Buehl published patent application is not the filing date of the Buehl provisional patent application but rather the filing date of the Buehl utility patent application itself.

As stated indicated above, the Buehl utility patent application was filed on January 18, 2002, and the filing date of this patent application is March 29, 2001. Consequently, Buehl, at least with respect to disclosure about a default rate and a custom rate, or a rate key, is not proper prior art under 35 U.S.C. § 102(e) (or, indeed, any section of 35 U.S.C. § 102). Accordingly, under 35 U.S.C. § 102, claims 34-37, 46, and 51 are allowable.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claim 1 is directed toward a system for delivering digital content on demand in a multiple unit environment, the system comprising: a server local to the multiple unit environment, the server including a memory storing the digital content and content metadata about the digital content stored in the memory of the server, and capable of supporting multiple simultaneous asynchronous accesses to the digital content; a billing system for billing each individual unit based on use of the digital content, the billing system coupled to the server and the content metadata including a default rate for the digital content and a custom rate for the digital content; and at least one access system in a plurality of units in the multiple unit environment, the access system designed to access the digital content stored in the memory on the server. Claims 2-11, 13-18, 20-33, 55-66 depend from claim 1.

Claims 38-42, 45, 47-50, and 67-86 depend from claim 34, described above.

In rejecting claims 1-11, 13-18, 20-33, 38-42, 45, 47-50, 55-86, the Examiner has relied on various other references in combination with Buehl: namely, Ellis, Hendricks, and Gordon. Ellis teaches a client server interactive television program guide system. The system provides programming guide data to television distribution facilities. Users may filter the programming guide data based on the user's preferences. The system may track users viewing histories and provide customized programming guide data. See Ellis, Abstract, col. 1, l. 45 - col. 2, l. 63.

Hendricks teaches an Operations Center for television entertainment systems to organize and package television programming and information for delivery to and from consumer homes. The Operations Center organizes and packages programming and information for delivery. See Hendricks, Abstract. The information may include a review of a users monthly account. See Hendricks, col. 43, ll. 60-61.

Gordon teaches network for transmitting viewable data objects to viewer receivers. Servers store viewable data objects that may be accessed by viewer receivers. See Gordon, ¶ 11. Users may browse and request the viewable data objects. See Gordon, ¶¶ 12-13.

The Examiner refers to Buehl as teaching the features of a default rate, a custom rate, and a rate key, and relies on these other references to teach features the Examiner acknowledges are absent from Buehl. These particular features are described in independent claims 1 and 34, and so are features of all pending claims. The Applicant asserts that Ellis, Hendricks, and Gordon do not teach these features. (The Examiner has already explicitly acknowledged that Gordon does not teach the concept of a default rate and a custom rate, on page 6 of the Office Action dated October 6, 2005.) And, as argued above, Buehl is not entitled to the priority date of the Buehl provisional patent application, so Buehl is not proper prior art under 35 U.S.C. § 102 and is not available as a reference under 35 U.SC. § 103(a).

MPEP § 2142 describes three basic criteria to establish a prima facie case of obviousness: "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." As the prior art references cited by the Examiner all fail to teach at least these features of the claims, the Examiner has failed to establish a prima facie case of obviousness. Accordingly, claims 1-11, 13-18, 20-33, 38-42, 45, 47-50, 55-86 are allowable under 35 U.S.C. § 103(a) over the various references.

Claim 5 is directed toward a system according to claim 1, further comprising controls for randomly accessing the digital content. The combination of Gordon and Buehl does not teach or suggest randomly accessing the digital content as recited in claim 5. Paragraph 45 of Gordon describes "commands may include pausing, resuming, fast forwarding, and rewinding the streaming object." All of these commands disclosed in Gordon are in reference to the current point in the streaming object. Pausing and resuming either stop at the point, or resume from that point. Fast forwarding and rewinding both begin at the current point. Nowhere is a command disclosed to access a random point in the streaming object: that is, a point that does not use the current point as a reference point. The addition of Buehl does not cure the deficiencies of Gordon. As a result, the combination of Gordon and Buehl does not teach or suggest each and every element of claim 5.

As neither Gordon nor Buehl teach or suggest randomly accessing content (in addition to neither reference teaching or suggesting a default rate, a custom rate, or a rate key), claim 5

is patentable under 35 U.S.C. § 103(a) over Gordon in view of Buehl. Accordingly, claim 5 is allowable.

For the foregoing reasons, reconsideration and allowance of claims 1-11, 13-18, 20-42, 45-51, and 55-86 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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